

REMARKS/ARGUMENTS

This reply is in response to the Advisory Action dated July 28, 2006, and to the Final Office Action dated April 18, 2006. Claims 1-208 are pending in the application, claims 135-169 have been withdrawn from consideration by the Examiner, and claims 1-134 and 170-208 stand rejected. Applicant is re-submitting his entire response, as his previous response after Final was not entered, according to the Advisory Action. Applicant has set out the reasons he believes that not entering the previously-filed Amendment was in error.

Applicant has amended claims 2, 5, 11, 12, 14, 28, 44, 47, 53-54, 56, 70, 172, 175, 181-182, 184, and 198 to merely incorporate features of the independent claims from which they respectively depend, thus merely presenting those claims in independent form. Accordingly, this is believed to place the application in condition for allowance. Applicant is aware that the application status is after-Final; however, Applicants respectfully submit that such claim amendments do not raise new issues or require an additional search, since the dependent claims have been searched and considered by the Examiner already. Applicant has simply presented those dependent claims in independent form, which should be acceptable at this point in prosecution.

Applicant respectfully disagrees with the Examiner's conclusion in the Advisory Action that Applicant has added new product-by-process limitations. Although the Advisory Action is not specific on this topic, Applicant believes that these conclusions relate to claims 172, 175, 181-182, 184, and 198. To the extent that these claims include recitations of product-by process limitations, Applicants respectfully submit that cancelled claim 170, from which each of these claims originally depended, contained the same limitations. Their incorporation into claims 172, 175, 181-182, 184, and 198 merely to present them in independent form cannot, by definition, raise a new issue or introduce new matter. Applicant respectfully requests that the Examiner reconsider the statement in the Advisory Action on this point. Thus, entry of the foregoing amendment and reconsideration of the claims is, again, respectfully requested.

Applicant has also cancelled claims 1, 15-27, 34-39, 43, 57-69, 76-81, 89-170, 185-197, and 204-208 without prejudice to or disclaimer of the subject matter contained therein. Applicant has cancelled those claims to reduce issues for appeal and/or to place the application in

condition for allowance, preserving the right to pursue the cancelled subject matter in one or more continuation or divisional applications.

Claims 1-134 and 170-208 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-25 and 47-60 of co-pending Application No. 10/469,072. Claims 1-134 and 170-208 are also provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-42 and 64-81 of co-pending Application No. 10/472,871.

Regarding the obviousness-type double patenting rejections, Applicants respectfully submit that, due to the still-changeable nature of the claims, these rejections should be held in abeyance, *e.g.*, until such point as the pending claims are allowable but for such double patenting rejections. At that juncture, Applicants will, if necessary, submit the appropriate terminal disclaimer(s) to obviate any then-pending double patenting rejections. Applicants respectfully submit that these rejections are not ripe for resolution until there are otherwise allowable claims in the instant case and allowed or issued claims in the cases to which terminal disclaimers are sought. Indeed, Applicants respectfully note that the M.P.E.P. instructs the Examiner to withdraw a provisional double patenting rejection in the earlier filed of two pending applications and to allow that earlier filed application to issue as a patent without a terminal disclaimer. *See* M.P.E.P 804(I)(B)(1).

Claims 1, 14-43, 56-89, 102-134, 170-172, and 184-208 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Domine *et al.* (WO 02/078953; hereafter "Domine"). Applicant has amended the claims as discussed above, obviating this rejection. Withdrawal of the rejection and allowance of the claims is respectfully requested.

Applicant notes the inconsistency considering the subject matter of claim 172. Claim 172 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Domine, yet the Examiner states that Domine does not disclose "amine-containing monomers" *See*, Final Office Action at page 5, paragraph 11. Withdrawal of the rejection or clarification is respectfully requested.

Claims 2-13, 44-55, 90-101, and 172-183 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Domine as applied to claims 1, 43, 88, and 170 above, and further in view of Iovine *et al.* (U.S. Patent No. 4,948,822; hereafter "Iovine"). The Examiner states that

Domine does not teach a polymer including an amine-containing monomer or an epoxy-containing monomer. The Examiner then states, "Iovine discloses a laminating adhesive comprising an acrylic acid alkyl or hydroxyalkyl ester monomer, glycidyl methacrylate, or an amine-containing copolymerizable comonomer. Iovine further teaches that the adhesive exhibits bond strength, and increased water and humidity resistance." The Examiner, therefore, asserts that it would have been obvious "to have employed the adhesive comprising a copolymer of and acrylic acid and glycidyl methacrylate or an amine-containing comonomer, as taught by Iovine, in the laminate of Domine, for the purposes of enhancing bond strength, and water and humidity resistance."

Applicant respectfully traverses the rejection on grounds that the Examiner has not established a *prima facie* case of obviousness. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Furthermore, the proposed modification cannot render the prior art unsatisfactory for its intended purpose. *In re Gordon*, 221 USPQ 1125 (Fed. Cir. 1984). If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. See *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984); see also M.P.E.P. § 2143.01.

At the very least, the proposed modification to Domine would render its laminates unsuitable for their intended purpose, which is to be extruded. As presented to the Examiner previously, the polymers/resins of Iovine are not extrudable and cannot be co-extruded. Iovine discloses laminating adhesives that incorporate acrylic polymer emulsions. See Iovine at Abstract; col. 2, ll. 22-31; and col. 3, ll. 37-48. Iovine further teaches applying those aqueous phase adhesives (polymer emulsions) to a film to form a laminate (*i.e.*, not co-extruded). *Id.* at col. 6, ll.22-37, and the Examples. As such, the emulsions of Iovine are not extrudable and cannot be extruded with the polymers of Domine.

Therefore, a combination of Domine and Iovine does not arrive at the claimed invention. More importantly, the addition of the non-extrudable copolymers of Iovine to Domine's polymers would render Domine 's laminates unsuitable for their intended purpose which is to be extruded.

Therefore, there is no suggestion or motivation to make the proposed modification. *See In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984); *see also* M.P.E.P. § 2143.01. Withdrawal of the rejection and allowance of the claims is respectfully requested.

The Examiner further states, "It has also been within the skill in the art that glycidyl (meth)acrylate and amines are conventional hardeners commonly used in the art. Thus, copolymer having glycidyl and/or amine units would also have higher abrasion resistance." Applicant timely disagreed with the Examiner's foregoing conclusion and requested evidence from the prior art to substantiate such an allegation. No such evidence has been provided.

The Examiner is reminded that "rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Lee*, 277 F.3d 1338, 1343-46 (Fed. Cir. 2002); *see also* M.P.E.P. § 2142. In other words, the Examiner must "explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious." *See In re Kahn*, 04-1616 (Fed. Cir. March 22, 2006). If no explanation is provided, then it is inferred that the Examiner used hindsight. *See Id.*

Here, the motivation to combine the references identified by the Examiner, namely that glycidyl (meth)acrylate and amines are conventional hardeners and would produce copolymers having higher abrasion resistance, is merely an unsupported legal conclusion that the combined elements provide an obvious result. Unsupported legal conclusions and impermissible hindsight may not provide a proper basis to support a rejection based on *prima facie* obviousness. Therefore, the Examiner erred in rejecting the claims under 35 U.S.C. §103(a). Withdrawal of the rejection is respectfully requested.

Claims 5-13, 28-35, 47-56, 70-77, 93-101, 116-123, 175-183, and 198-205 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Domine as applied to claims 1, 43, 88, and 170 above, and further in view of Kojima *et al.* (U.S. Patent No. 4,654,255; hereafter "Kojima"). The Examiner states that Domine does not disclose an epoxy-containing monomer. The Examiner then states that Kojima discloses an adhesive "comprising epoxy-containing olefin polymers that are the same as recited in the instant claims such as glycidyl acrylate." The

Examiner, therefore, asserts that it would have been obvious to "have employed the adhesive comprising a copolymer of an olefin and glycidyl methacrylate, as taught by Kojima, in the adhesive of Domine, for the purpose of enhancing interlaminar bond strength between layers in laminates."

Applicant respectfully traverses the rejection on grounds that a combination of Domine and Kojima does not teach, show, or suggest the claimed invention. As presented to the Examiner previously, the copolymers described in Kojima are not coextrudable. Kojima discloses an epoxy-containing olefin copolymer having an acid monomer where the acid is grafted to the epoxy-containing olefin polymer in the presence of a radical generator. Kojima at Abstract and col. 3, ll. 6-63. The copolymers of Kojima "are applicable as a solution in solvent, or by a powder coating method" (*i.e.*, not coextrudable). Kojima at col. 8, ll. 37-40. Additionally, the copolymers of Kojima are unlikely to flow at extrusion temperatures (100°C-300°C) because the copolymers of Kojima are graft reacted at those temperatures (100°C-300°C) and because of the copolymers' high bond strengths, as reported in Table 1 of the examples. *Id.* at col. 4, lines 50-58, and at the examples. As such, the copolymers described in Kojima are not coextrudable.

Therefore, a combination of Domine and Kojima does not arrive at the claimed invention. More importantly, the addition of the non-extrudable copolymers of Kojima to Domine's polymers would render Domine's laminates unsuitable for their intended purpose which is to be extruded. Therefore, there is no suggestion or motivation to make the proposed modification. *See In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984); *see also* M.P.E.P. § 2143.01. Withdrawal of the rejection and allowance of the claims is respectfully requested.

CONCLUSION

Having addressed all issues set out in the office action, Applicant respectfully submits that the pending claims are now in condition for allowance. Applicant invites the Examiner to telephone the undersigned attorney if there are any issues outstanding which have not been addressed to the Examiner's satisfaction.

Respectfully submitted,

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Date



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